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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,470	10/31/2003	Bruce Ernest Tepper	9406	2772

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EXAMINER
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LE, HOA T

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/699,470

Applicant(s)

TEPPER ET AL

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/2004 &amp; 03/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 and 7-10, drawn to volatile substance-controlling composition and article, classified in class 428, subclass 323.
  - II. Claim 6, drawn to impregnating method, classified in class 427, subclass 212.
  - III. Claims 11 and 12, drawn to a method of making volatile substance-controlling composition, classified in class 264, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as making a wall panel containing the composition as fillers.
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

instant case the product as claimed can be made by another and materially different process such as the impregnating step can be done manually (e.g. by hand).

4. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the process of invention II requires impregnation while the process of invention III (subcombination) is a simple mixing process. The subcombination has separate utility such as fillers for sintered product.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Applicant's Representative, Dara Kendall, on July 14, 2005, a provisional election was made with traverse to prosecute the invention of group I, claims 1-5 and 7-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 11 and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

8. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim 1 requires *at least one* PRM in the fragrance component. Claim 3 recites *one or more* PRM in the fragrance component. The meaning of “at least one” and “one or more” is the same. Thus claim 3 does not further limit the subject matter of claim 1 on which it depends.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The specification does not provide any teaching as to how to attain the goal as claimed; that is, how the fragrant component can be controlled in such a way that when a volatile substance is present, the fragrance component is released at least one thousand times higher than when the volatile substance is absent. The specification states that, “[i]t is desirable that at least a portion of the fragrance component is released in the presence of the volatile substances at levels at least one thousand times higher than in their absence under ambient conditions” (emphasis added). However, the instant specification fails to disclose how that goal can be attained. Thus, based on the instant disclosure, such goal remains to be “desirable” but not “attainable”.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the term “perfume raw material” or the abbreviation “PRM” renders the claim indefinite. The term “perfume raw material” is not an art-recognized or art-accepted term.<sup>1</sup> Replacing the term by a term that is well-defined or recognized in the art is required.

In claim 2, it is unclear what the term “ion exchange resin” denotes.

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<sup>1</sup> The term “PRM” though does not render the specification inadequate because it has been used loosely in the fragrance market, its use in claims is not acceptable for its meaning is not well-established in the art.

Claims 3 and 4 suffer the same deficiency of claim 1.

Claim 10 is unclear in that when the substrate takes the form of beads, it cannot be seen how that could form a "sheet material" as the preamble dictates.

Other claims are deemed indefinite in view of their dependency upon claim 1.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by the Kobayashi patent (JP 60-018,171).<sup>2</sup>

Claim 1: The Kobayashi patent teaches a composition comprising an "impregnable body" and fragrances impregnated in the 'impregnable body'. See page 3, lines 1-2. The 'impregnable body' comprises any material that can absorb liquid (page 5, lines 11-12), thus it is a sorbent according to the definition in the instant specification. The sorbent or impregnable body is capable of absorbing volatile substance by definition.

Claim 2: See page 5, third paragraph.

Claim 3: See page 4, last paragraph.

Claim 4: See page 3, last paragraph and page 4, first paragraph.

Claims 7 and 10: See page 5, last paragraph.

*Claim Rejections - 35 USC § 103*

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Kobayashi patent (JP 60-018,171 as applied to claims 1-5, 7 and 10 above, and further in view of one of the following US patents: 5,556,394; 5,554,144; 5,554,143; 5,554,142; 5,643,588; 5,624,426; 5,609,587; 5,607,760; 5,575,784; 5,558,661; 5,997,521; 5,968,025; 5,906,603; 5,957,906; 6,118,041; and 6,107,537.

The Kobayashi patent teaches the volatile substance-controlling composition as discussed above. The Kobayashi patent also teaches incorporating such composition into an article (page 5, last paragraph). Though implied, the Kobayashi patent does not explicitly describe the use of such composition in various structures as claimed. Each of the aforementioned US patents teaches the layered odor-absorbing structure as claimed. It would have been obvious for one having ordinary skill in the art to incorporate the composition in the structure taught in any of the aforementioned US patents in order to produce an article that provides dual function: odor or volatile substance-absorbing as well as fragrant releasing.



17. References, which teach different methods of regulating fragrance, release are cited as art of interest.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. T. Le  
Primary Examiner  
Art Unit 1773